

REMARKS

Claims 1-12 are pending and under consideration. Claim 1 has been amended. Support for the amendment to claim 1 may be found in the claims as originally filed, and in the specification at, *inter alia*, at page 7, lines 11, 12, and 13, and at page 8 lines 4, 5, and 6. This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

**Response to Arguments:**

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. Although, as noted in the final Office Action at page 5, in section 4, the claims do not recite "thus render a separate authentication process unnecessary," the claims do recite a "menu registration identifier" which renders a separate authentication process unnecessary. None of the cited references, in contrast, recite such a "menu registration identifier" and therefore the cited references do require such a separate authentication process.

The gateway of Nitaki, for example, downloads the contents data from the content server *if the request is valid*, as noted in the final Office Action. Thus, in Nitaki, there is a separate authentication process to determine if the request is valid, before the contents are downloaded. In particular, as described in Nitaki at paragraph [0110]:

At step S31, the address is transmitted to the gateway 22 as a request for use. Subsequently, a standby state is entered to wait for the reception of a user ID and PW associated with the request which are assigned by the gateway 22 (step S32: N). When the user ID and PW are received (step S32: Y), menu data for accessing the requested contents service which are simultaneously received are stored in the storage device and are registered as access request screen data (step S33).

Thus, in Nitaki, a user ID and PW associated with the request must be received before the contents are downloaded. This is to be contrasted with the claimed invention, in which "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone."

Furthermore, in Nitaki, the ID and PW must be input at the menu screen for accessing the relevant contents service. In particular, as described in Nitaki at paragraph [0111]:

When the access request screen is selected at step S30 (step S30: Y) or after a request for use is transmitted at step S31 to register a new menu screen, the input of the ID and PW is accepted according to the menu screen for accessing the relevant contents service (step S34). Thereafter, a request for use consisting of the ID and PW accepted at step S34 is transmitted to the gateway 22 at step S35. At step S36, reception of contents data associated with the request for use is monitored (step S36).

Thus, in Nitaki, the ID and PW must be input at the menu screen for accessing the relevant contents service. This is to be contrasted with the claimed invention, in which "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone."

Finally, in Nitaki, the gateway 22 downloads contents data from the contents server 21 to the portable terminal 20 when a valid access request is received from the portable terminal 20. In particular, as described in Nitaki at paragraph [0113]:

When an access request is received from the portable terminal 20 and the access request is valid, the gateway 22 downloads contents data from the contents server 21 and transfers the contents data to the portable terminal 20. The gateway 22 will now be described.

Thus, in Nitaki, the gateway 22 downloads contents data from the contents server 21 to the portable terminal 20 when a valid access request is received from the portable terminal 20. This is to be contrasted with the claimed invention, in which "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone."

Still, in the interest of compact prosecution only, and not for any reason of patentability, the fourth clause of claim 1 has been amended in accordance with the Examiner's implied suggestion at page 5 of the final Office Action, in section 4, to recite:

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone and renders a separate authentication process unnecessary.

The Examiner's suggestion is appreciated. Further reconsideration is thus requested.

#### **Claim Rejections - 35 U.S.C. § 103:**

Claims 1, 2, 5, 7, 11, and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese Publication No. JP 2000-333258 to Hiromoto (hereinafter "Hiromoto") in view of U.S. Patent Application Publication No. 2001/0005890 to Nitaki (hereinafter "Nitaki"). The

rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is requested.

Normally, a content provider sends content to the user's portable telephone, but the bill for the content, including charges for the content sent by the content provider, is sent to the user from the communications carrier, i.e. a proxy payment service. Thus, the communication carrier needs to know which content was accessed by the user, in order to bill the user. In order to keep track of which content was accessed by the user, the communication carrier requires the user to register with its own user menu information database as well. In particular, as described in the present specification at page 5, lines 2-14:

In this manner, the user can enjoy one-window payment through the proxy payment service, which is more convenient than the case where a credit card is used, with an added advantage that uneasiness and various problems are avoidable. However, since the billable content services for which the user can use the proxy payment service are limited to the content services registered in the communications carrier's content provider menu information database 25, a payment from a user to a content provider has to be directly made for billable content services that are not registered.

However, in the conventional method, if the user sets up a "my," or personal, menu, and accesses the content of the content provider through the "my" menu, the content provider will be unable to recognize whether or not the access of the user comes through the "my" menu. To avoid missing the access, content providers require the user to register in order to access the content as well, as described in the specification at page 5, lines 24-33.

In the claimed invention, in contrast, the menu registration identifier allows the content provider to provide content to the user's portable phone without a separate registration process for the content. The menu registration identifier thus renders such a separate authentication process unnecessary. Therefore, it is possible to improve operability and ease of access to the content of the content provider, by dispensing with separate registration steps.

The fourth clause of claim 1, in particular, recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as recited in claim 1. In Hiromoto, rather, the information menu center holds the contract information about information offered to a user, as noted adroitly in section 2 at page 2 of the final Office Action. Since, in Hiromoto, the information menu center holds the contract

information about information offered to a user, the content provider is registering the user separately, as discussed above, and so Hiromoto is not “providing the requested content service directly from the content provider to the user’s portable telephone,” as recited in claim 1.

Similarly, in Nitaki, gateway 22 assigns a user ID and a password to the user the first time it receives an access request from the portable terminal 20, and transmits them to the portable terminal 20. In particular, as described in the Abstract:

When the gateway 22 receives the first request for access from the portable terminal 20, it assigns a user ID and a password to the same and transmits them to the portable terminal 20. When another request for use added with the same ID and PW is received, the gateway 22 generates access history information after authenticating the user and grants an access right during a predetermined effective period from the date of the first access.

Since, in Nitaki, gateway 22 assigns a user ID and a password to the user, the content provider is registering the user separately, as discussed above, and so Nitaki is not “providing the requested content service directly from the content provider to the user’s portable telephone,” as recited in claim 1.

The fourth clause of claim 1 recites further:

And renders a separate authentication process unnecessary.

Neither Hiromoto nor Nitaki teach, disclose, or suggest “and renders a separate authentication process unnecessary,” as recited in claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2 and 12 depend from claim 1 and add further distinguishing elements. Claims 2 and 12 are also submitted to be allowable. Withdrawal of the rejection of claims 2 and 12 is earnestly solicited.

Claim 5:

The sixth clause of claim 5 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user’s portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, “the menu registration identifier allows providing the requested content service directly from the content provider to the user’s portable telephone,” as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not

result. Claim 5 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 5 is earnestly solicited.

Claim 7:

The fourth clause of claim 7 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 7 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim 11:

The fourth clause of claim 11 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 11 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 11 is earnestly solicited.

Claims 2, 3, 4, 6, and 8-11:

Claims 3, 4, 6, and 8-11 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nitaki in view of Hiromoto. The rejection is traversed. Reconsideration is requested.

The sixth clause of claim 3 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 3 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 3 is earnestly solicited.

Claim 4 depends from claim 3 and adds further distinguishing elements. Claim 4 is thus also submitted to be allowable. Withdrawal of the rejection of claim 4 is earnestly solicited.

Claim 6:

The third clause of claim 6 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 6 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 6 is earnestly solicited.

Claim 8:

The fifth clause of claim 8 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 8 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 8 is earnestly solicited.

Claims 9 and 10 depend from claim 8 and add further distinguishing elements. Claims 9 and 10 are thus also submitted to be allowable. Withdrawal of the rejection of claims 9 and 10 is earnestly solicited.

Claim 11:

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 11 as unpatentable over Hiromoto in view of Nitaki. Thus, even if Hiromoto and Nitaki were combined as proposed in the final Office Action, the claimed invention would not result. Claim 11 is also submitted to be allowable. Withdrawal of the rejection of claim 11 is earnestly solicited.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-12 are allowable over the cited references.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By:

Thomas E. McKiernan  
Registration No. 37,889

Date: 14DE06

1201 New York Ave, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501